

R E M A R K S

- Claims **1 – 59 and 83 – 94** are currently pending in the application.
- Claims **1 – 59 and 83 – 94** stand rejected.
- Upon entry of this amendment, which is respectfully requested, claims **83 – 89** will be cancelled, without prejudice or disclaimer, and claims **1, 90, 93 and 94** will have been amended.
- Of the claims that will remain pending upon entry of this amendment, only claims **1, 90, 93 and 94** are independent.

1. Abstract

The abstract of the disclosure has been objected to as exceeding the suggested range of 50 to 150 words. The abstract has been shortened herein such that it does not exceed 150 words.

2. Section 101 Rejection

Claims **1 – 11, 13, 15 – 59, 83 – 89, 93 and 94** stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In particular, the basis for the rejection appears to be that “the body of the claims...have no connection to the technological arts...none of the steps indicates any connection to a computer or technology...could be performed manually by a person.” Current Office Action, page 5.

There is no statutory, regulatory or case law basis for this rejection. The proper, and only, legal test for the presence of statutory subject matter is only that a claimed process or apparatus produce a “useful, concrete and tangible result.” State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1375, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998), cert. denied, 525 U.S. 1093, 142 L.Ed.2d 704, 119 S.Ct. 851 (1999). While other criteria, if satisfied, may be useful in indicating the presence of a “useful, concrete and tangible result” (and therefore indicate that a claim is directed to statutory subject matter), the absence of such criteria does not preclude a finding of statutory subject matter. The “ultimate issue” always has been whether a claim as a whole is drawn to statutory subject matter. See, AT & T Corp., 172 F.3d at 1359. Such other criteria are not requirements, but merely some of several ways that can demonstrate that an invention produces a useful, concrete and tangible result.

For example, the reciting of physical limitations may be helpful, but not necessary to render a claim statutory. AT & T Corp., 172 F.3d at 1359 (“Whatever may be left of the earlier test, if anything, this type of physical limitations analysis seems of little value...”). Even where a claim incorporates a mathematical algorithm, in contrast to focusing on a physical limitations inquiry, the inquiry deemed the “ultimate issue” “focuses on whether the mathematical algorithm is applied in a practical manner to produce a useful result.” AT & T Corp., 172 F.3d at 1359 – 60.

In another example, a physical transformation by a claimed process is one example (but not a requirement) of how a mathematical algorithm may bring about a useful application. AT & T Corp., 172 F.3d at 1357. See also, Diamond v. Diehr, 450 U.S. 175, 192, 67 L.Ed.2d 155, 169, 101 S.Ct. 1048, 1059 – 60 (1981) (the “e.g.” signal denotes that physical transformation is an example, not an exclusive requirement for satisfying §101); Arrhythmia Research Tech., 958 F.2d

1053, 1060, 22 USPQ2d 1033, 1039 (Fed. Cir. 1992) (the transformation simply confirmed that Arrhythmia's method claims satisfied §101 because the method produced a number which had specific meaning – a useful, concrete, tangible result – not a mathematical abstraction).

The pending claims are directed to statutory subject matter because they each produce a useful, concrete and tangible result (e.g., buyer offers and seller offers are matched based on an evaluation rule).

However, solely to expedite allowance of the pending claims and without prejudice or disclaimer of any claim matter, Applicants have amended independent claims **1 and 94** to recite “technology” in the body of the claim. Specifically, Applicants have amended claims **1 and 94** to recite that the step of matching is performed by a controller facilitating a transaction.

Claims **83 – 89** are being cancelled herein. Accordingly, the 101 rejection of these claims is moot.

Claim **93** is an article of manufacture claim directed to a medium storing instructions adapted to be executed by a processor and is thus directed to “the technological arts” and to statutory subject matter. See, for example, MPEP 2106 (IV)(B)(1)(a): “A claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional inter-relationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.”

3. Section 112 Rejections

Claims **23, 24 and 28** stand rejected under 35 U.S.C. §112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Current Office

Action, page 6, paragraph 4.1. Applicants respectfully traverse this rejection for the reasons set forth below.

With respect to claims **23 and 24**, it has been asserted that “it is unclear as how the evaluation rule based upon revenue management information...are functionally integrated with the step of matching the buyer and seller offers recited in claim 1...”. Current Office Action, page 6, paragraph 4.1. With respect to claim **28**, it has been asserted that “it is unclear how the measure of current performance of the controller and determining the evaluation rule based on the current performance of the controller are functionally integrated with the step of matching the buyer and seller offers based upon the evaluation rule as recited in claim 1.” Current Office Action, bottom of page 6 to top of page 7.

First, Applicants have searched the patent laws, regulations and MPEP for a requirement that steps of a method be “functionally integrated” and have been unable to find any reference to such a requirement. Accordingly, Applicants respectfully request withdrawal of this rejection or, if the rejection is maintained, further clarification as to the basis for this rejection.

Second, if Examiner intended to base the rejection on a requirement that the steps be “functionally interrelated” or “interdependent”, Applicants respectfully submit that this is not a requirement under §112, second paragraph, as explicitly stated in the MPEP:

“[I]t is not essential to a patentable combination that there by interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result” MPEP 2172.01, quoting *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965).

“A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and / or serve independent purposes.” MPEP 2172.01, quoting *Ex parte Huber*, 148 USPQ 447, 448 – 449 (Bd. Pat. App. 1965).

A claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under the second paragraph of Section 112 for failing to point out and distinctly claim the invention. MPEP 2172.01. However, nowhere in the specification have Applicants defined the elements of claims **23, 24 or 28** as essential elements of the invention.

Third, the relationship between the elements of claims **23, 24 and 28** and the step of matching in claim **1** is clear from the claims as recited. Claim **1** recites a step of determining an evaluation rule. The evaluation rule is used to match seller offer information and buyer offer information, as also recited in claim **1**. Claims **23, 24 and 28** each recite a respective manner in which the evaluation rule used to so match the buyer offer information and seller offer information is determined. For example, claim **23** recites the step “determining the evaluation rule” that is recited in claim **1** (i) is performed periodically (i.e., the evaluation rule is determined periodically), and (ii) is based on revenue management information associated with the controller (i.e., the evaluation rule is determined based on revenue management information associated with the controller recited in claim **1**), in accordance with one embodiment. Thus, for example, an evaluation rule for use in matching buyer offer information and seller offer information may be determined periodically based on revenue management information. Claim **24** further defines “revenue management information” that is the basis for determining the evaluation rule, in accordance with one embodiment. Claim **28** recites that the

additional step of “measuring a current performance of the controller”, the controller being recited in claim 1. Claim **28** additionally refines how the evaluation rule is determined, specifically reciting that determining the evaluation rule comprises determining the evaluation rule “based on the current performance of the controller.” Thus, the evaluation rule that is used to match buyer offer information and seller offer information may be determined based on the current performance of the controller.

As illustrated, there is a clear inter-relationship between the elements of claims **23, 24 and 28** and the independent claim from which each of claims **23, 24 and 28** depends. As is further clear, the relationship between claims **23, 24 and 28** and the step of matching buyer and seller offer information is that claims **23, 24 and 28** each recite a manner in which the evaluation rule used in the step of matching may be determined. For at least this reason, Applicants respectfully submit that claims **23, 24 and 28** are proper and request that the rejection of these claims be withdrawn.

4. Section 102 Rejections

Claims **1 – 15, 19 – 48, 50 – 59 and 83 – 94** stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,598,026 to Ojha et al. (“Ojha” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

4.1. Claims 1 – 15, 19 – 48 and 50 – 59, 90 and 93

Ojha does not teach the following claim limitation, which is recited in independent claims **1, 90 and 93** as amended to recite a feature according to an embodiment of the invention:

- *matching seller offer information and buyer offer information based on an evaluation rule, wherein the evaluation rule is a rule other than a search term input by the buyer*

Ojha teaches a system wherein a buyer may search a database for current product information for a variety of products being offered for sale by a number of sellers. Col. 2, lines 54 – 57. Each product in the database is offered for sale by one of a plurality of sellers. Col. 2, lines 55 – 59. The buyer may submit a bid to a seller associated with a product found by the seller during a search of the database. Col. 3, lines 6 – 20. The bid may be responded to automatically based on one or more rules specified by the seller. Col. 3, line 66 – col. 4, line 3.

Accordingly, the buyer's bid and the product offered for sale by the buyer are not *matched* based on the rules specified by the seller, as implied by the Examiner. (See, for example, Current Office Action, page 8). Rather, after the buyer selects a seller or product based on a search of a database by the buyer, the rules specified by the seller may be used to automatically *generate a response* to the buyer's bid. It appears that this rejection is based either on a presumption that generating a response to a buyer's bid is equivalent to matching buyer offer information or on a presumption that the facilitating of a completion of a transaction as a result of the generated response is equivalent to matching buyer information and seller information. Neither *generating a response* to a buyer's bid nor *facilitating a completion of a transaction* between the seller and the buyer is equivalent to *matching* buyer offer information and seller offer information. No reasoning has been presented regarding whether or why these distinct concepts should be considered equivalent. Further, neither generating a response to a bid based on rules specified by a seller nor facilitating the completion of a transaction

based on these rules can be performed unless the buyer's bid has been already associated with the specific seller. Thus, the rules specified by the seller cannot be interpreted as being used to match the seller or product offered for sale by the seller with the buyer's bid, as such a step would be unnecessary and superfluous at the time the response to the buyer's bid is being generated (i.e., since the seller or seller's product has already been associated with the buyer's bid).

At least because Ojha does not teach or suggest *matching seller offer information and buyer offer information based on an evaluation rule, wherein the evaluation rule is a rule other than a search term input by the buyer*, Applicants respectfully submit that Ojha does not anticipate claims **1 – 15, 19 – 48, 50 – 59, 90 and 93**. Accordingly, Applicants request reconsideration and withdrawal of the §102(e) rejection of these claims.

Claims **83 – 89** have been cancelled herein, without prejudice or disclaimer. Accordingly, the rejection of these claims is moot.

4.2. Independent Claim 94

Ojha does not disclosure the following set of features of independent claim **94**:

- *determining a seller code based on the seller offer information;*
- *determining a buyer offer code based on the buyer offer information;*
- *and*
- *matching the seller offer code and the buyer offer code*

It has been asserted that Ojha discloses this limitation at least at col. 3, line 66 – col. 4, line 23 and col. 4, lines 49 - 67. Specifically, it has been asserted that “the buyer's bid and seller's acceptance of the bid correspond to the buyer;s code and seller's code respectively.” However, upon reviewing these passages, as well as the remainder, of Ojha Applicants have been unable to find any disclosure of

either a seller offer code or a buyer offer code. No support has been provided for the proposition that a buyer's bid should be considered equivalent to a buyer offer code and the seller's acceptance of the bid should be considered equivalent to a seller offer code.

Further, Ojha cannot be interpreted in a manner that would anticipate the embodiment of claim **94**. In claim **94**, information associated with a buyer is received and, in a distinct step, a code is generated based thereon. In contrast, in Ojha a buyer's bid is received and simply "made available" to a seller. Col. 4, lines 55 – 57. No "buyer offer code" or any other data used for matching is determined based on the buyer's bid. Similarly, claim **94** recites information associated with a seller being received and, in a distinct step, a seller offer code being determined based thereon. In contrast, in Ojha the seller's acceptance is simply made available to the buyer. Col. 4, lines 57 – 58. No "seller offer code" or any other data used for matching is determined based on the seller's acceptance.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of the §102(e) rejection of independent claim **94**.

5. Section 103 Rejections

Claims **16 – 18 and 49** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ojha and further in view of U.S. Patent No. 6,415,320 to Hess et al. ("Hess" herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Claims **16 – 18 and 49** are dependent from claim **1**, which is patentable for the reasons discussed in Section 5 above. Hess, like Ojha, does not teach or suggest *matching seller offer information and buyer offer information based on an evaluation rule, wherein the evaluation rule is a rule other than a search term input by the buyer*. Accordingly, the combination of Hess and Ojha does not teach

or suggest this feature and claims **16 – 18 and 49** are patentable at least for the same reasons as claim **1**, discussed in Section 5 above.

Applicants further traverse the §103(a) rejection of claims **16 – 18 and 49** on the grounds that absolutely no motivation to combine the references has been provided by the Examiner. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims **16 – 18 and 49**.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461 - 7041 or via electronic mail at mfincham@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a **two month** extension of time with which to respond to the Office Action. If an additional extension of time is required in addition to that requested, please grant a petition for that extension of time which is required to make this Response timely.

Please charge as follows:

Charge: \$210.00

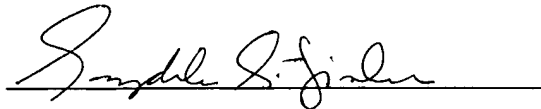
Deposit Account: 50-0271

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Charge any additional fees or credit any overpayment to the same account.

A duplicate copy of this authorization is enclosed for such purposes.

Respectfully submitted,



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Date